

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on October 24, 2006 (hereinafter “the Office Action”), and the references cited therein.

Claims 7, 14, and 29-32 are amended and claims 12-13 are canceled; as a result, claims 1-11, 14-21, and 29-36 are now pending in this application.

Claim Objections

Claim 32 has been objected to because of an informality. Claim 32 has been amended herein in a manner that is believed to remedy this informality.

35 USC § 101 Rejection of the Claims

Claims 29-31 were rejected under 35 USC § 101 as being nonstatutory. These claims have been amended in a manner that is believed to address the Examiner’s concerns.

35 USC §102 Rejection of the Claims

Claims 7 and 12 were rejected under 35 USC § 102(b) as being anticipated by Murakami et al. (U.S. Patent 6,483,929).

In section 15 of the Office Action, it states “the prior art of record fails to teach or suggest a wireless body appliance having (1) a wireless receiver that receives a wireless notification signal from a wireless device identifying an event that has occurred and (2) multiple different notification structures, wherein the wireless notification signal identifies which type of notification structure is to be used to notify the user of the event.” Independent claim 7 has been amended herein to include these limitations. Claim 12 has been canceled.

Based on the foregoing, it is submitted that claim 7 is now in form for allowance. Reconsideration and allowance of claim 7 is therefore respectfully requested.

35 USC §103 Rejection of the Claims

Claims 1-6, 15-20, and 29-31 were rejected under 35 USC § 103(a) as being unpatentable over Coughlin et al. (U.S. Publication 2004/0257202) in view of Smith (U.S. Publication 2003/0025603) and Xydis (US Patent 6,307,471).

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPRP § 2142.

The Examiner takes the position that Coughlin et al. is appropriate prior art in this case because the reference claims the benefit of U.S. provisional application nos. 60/479,752, 60/483,012, and 60/484,495. The Applicants respectfully disagree. For a U.S. application publication that claims the benefit of the filing date of a U.S. provisional application, the critical reference date is the filing date of the provisional application only if the provisional application properly supports the subject matter relied upon to make the rejection (see MPEP 2136.03(III)). None of the subject matter in Coughlin et al. relied upon by the Examiner in the present rejection is supported in the identified provisional applications. Reference to the three provisional applications using the public PAIR system shows that the descriptions of the three applications are relatively brief; that is, one page, two pages, and three pages, respectively. More importantly, none of the subject matter relied upon by the Examiner in the rejection is taught in these brief descriptions, which all have to do with a smart touch screen pointer that a user places on his finger tip. Because the actual filing date of Coughlin et al. is June 16, 2004, which is after the filing date of the present application, Coughlin et al. can only be used as prior art if the filing date of one or more of the provisional applications is used as the critical reference date. Because this is not possible, Coughlin et al. is not a valid reference for use in this rejection. The combination of references used in this rejection therefore does not teach or suggest all of the claim limitations.

Based on the foregoing, it is submitted that a *prima facie* case of obviousness has not been established with respect to claims 1-6, 15-20, and 29-31. Reconsideration and allowance of these claims is therefore respectfully requested. If the Examiner maintains this rejection, it is respectfully requested that she identify support within one or more of the provisional applications for the subject matter being relied upon in the rejection.

Claims 7, 11, and 12 were rejected under 35 USC § 103(a) as being unpatentable over Smith (US Publication 2003/0025603) in view of Murakami et al. (U.S. Patent 6,483,929).

As described above, claim 7 has been amended herein in a manner that is believed to place the claim in form for allowance. Claim 12 has been canceled. Claim 11 is a dependent claim that depends directly from independent claim 7. Consequently, claim 11 is allowable for at least the same reasons as claim 7.

Claims 8 and 9 were rejected under 35 USC § 103(a) as being unpatentable over Smith (US Publication 2003/0025603) in view of Murakami et al. (U.S. Patent 6,483,929) and further in view of Stockhammer (US Publication 2002/0190125).

Claims 8 and 9 are dependent claims that each depend directly from independent claim 7. Consequently, these claims are allowable for at least the same reasons as claim 7.

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Smith (US Publication 2003/0025603) in view of Murakami et al. (U.S. Patent 6,483,929) and further in view of Bianco et al. (US Patent 6,256,737).

Claim 10 is a dependent claim that depends directly from independent claim 7. Consequently, claim 10 is allowable for at least the same reasons as claim 7.

Claim 14 was rejected under 35 USC § 103(a) as being unpatentable over Smith (US Publication 2003/0025603) in view of Murakami et al. (U.S. Patent 6,483,929) and further in view of Gehlot (US Patent 6,256,737).

Claim 14 is a dependent claim that depends directly from independent claim 7. Consequently, claim 14 is allowable for at least the same reasons as claim 7.

Claims 32-35 were rejected under 35 USC § 103(a) as being unpatentable over Coughlin et al. (US Publication 2004/0257202) in view of Smith (US Publication 2003/0025603), Xydis (US Patent 6,307,471), and Deng et al. (US Publication 2003/0043078).

For reasons similar to those set out above in connection with the rejection of claims 1-6, 15-20, and 29-31, Coughlin et al. is not a valid reference for use in rejecting claims 32-35.

Based on the foregoing, it is submitted that a prima facie case of obviousness has not been established with respect to claims 32-35. Reconsideration and allowance of these claims is therefore respectfully requested.

Allowable Subject Matter

Claims 13, 21, and 36 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The subject matter of previous claims 12 and 13 has been incorporated into independent claim 7. Claims 21 and 36 have not been rewritten herein as it is believed that the corresponding independent claims (i.e., claims 15 and 32, respectively) are allowable for the reasons set forth above.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (480-948-3745) to facilitate prosecution of this application.

Respectfully submitted,

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By their Representatives,

Customer Number 45643
480-948-3745

Date: January 12, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12th day of January, 2007.

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